

Applicant : Mark Hans Emar
Patent No. :
Issued :
Serial No. : 09/486,977
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Attorney's Doct No.: 00167-404001 / 02-31-0340

REMARKS

The specification and drawings are amended to fix an inconsistency in the application. Specifically, the paragraph beginning on page 4, line 38 is amended to renumber a shut-off valve from element number 10 to 39. In addition, Fig. 2 is amended to renumber element 10 to 39. No new matter has been introduced. Support for these amendments can be found, at least at, for example, Figs. 1 and 3, and at page 5 of the originally-filed specification.

Prior to entering the attached amendment, claims 20-23 and 38 were pending. In the attached amendment, Applicant amends claim 20 and introduces new claims 39-56. Applicant submits that no new matter has been introduced. Support for the claim amendments can be found, at least at, for example, page 3 of the specification and Figs. 1 and 4. Applicant requests reconsideration and allowance of claims 20-23 and 38-56 in view of the attached amendment and the following remarks.

The Examiner rejected claims 20 and 21 as being anticipated by, or in the alternative, as obvious over U.S. Patent No. 5,163,433 issued to Kagawa *et al.*, and claims 22 and 23 as obvious over Kagawa *et al.* Applicant traverses this rejection.

Independent claim 20, as amended, recites "inserting into said cavity a device for cutting and detaching said tissue, said device being motor driven." Kagawa *et al.* fails to teach or suggest at least the claimed insertion of a motor driven device. The method of Kawaga *et al.* involves the use of an ultrasonic surgical instrument. Rather than being motor driven, the ultrasonic surgical instrument of Kawaga *et al.* employs piezoelectric elements and electrodes, with a power supply cord connected to the electrode 10b." See, e.g., Kagawa *et al.* at col. 5, lines 21-34.

Furthermore, applicants traverse the Examiner's characterization of the regulation of pressure in Kagawa *et al.*.

Therefore, for at least the reasons discussed above, claims 20 and its dependent claims are patentable over Kagawa *et al.*.

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The Examiner listed claim 38 as being rejected on page 1 of the final action, however the action fails to state the basis for the rejection. On page 4 of the action, the Examiner states under the heading "Response to Amendment" that "As to claim 38, Kawaga reference does disclose first path 21 and second path 26 separate from first path 21 because they essentially are one same path."

Claim 38 recites, in part, "discharging fluid with detached tissue along a first path, and discharging substantially only fluid along a second path separate from said first path" (emphasis added). Applicant respectfully submits that Kawaga *et al.* does not teach a first path which is separate from a second path, but rather, Kawaga *et al.* discloses paths 26 and 21 which are connected at suction tube 16. *See e.g.* Kawaga *et al.* at Fig. 1. It is precisely because paths 26 and 21 are essentially one same path that they cannot be separate paths.

Therefore, for at least this reason, claim 38 is patentable over Kagawa *et al.*.

Applicant believes the claims are in condition for allowance, which action is requested.

Enclosed is a check to cover additional claims fees, a Request for Continued Examination, and a Petition for Extension of Time. Please charge any additional fees or credits to Attorney's Deposit Account No. 06-1050.

Respectfully submitted,



Sean P. Daley
Reg. No. 40,978

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Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone (617) 542-5070
Facsimile (617) 542-8906
40174976.doc